UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Offic
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Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR		ATTORNEY DOCKET NO.
08/886,388	07/01/97	SANDHU	G	MI22-713

021567 MM91/0829
WELLS ST JOHN ROBERTS GREGORY AND MATKIN
SUITE 1300
601 W FIRST AVENUE
SPOKANE WA 99201-3828

EXAMINER	
CRANE,S	
ART UNIT	**PAPER NUMBER**
2811	

DATE MAILED: 08/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/886,388	Sandhu et al.
Examiner	**Group Art Unit**
Sara W. Crane	2811

☒ Responsive to communication(s) filed on *Jun 19, 1900*.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *44, 45, 51-54, 56, 58-60, 62-68* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *44, 45, 51-54, 56, 58-60, 62-68* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on *Jun 19, 1900* is ☒approved ☐disapproved. by the examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *21, 22*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 44-45, 51-54, 56, 58-60, 62, and 66-68 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

See reasons of record as discussed in the Office action of 3/15/00.

Claims 44-45, 51-54, 56, 58-60, 62, and 66-68 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

See reasons of record in the Office action of 3/15/00.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim 44, insofar as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Morihara et al. in view of Wolf et al.

See reasons of record in the Office action of 3/15/00.

Claims 44-45, 51-54, 56, 58-60, 62, and 66-68, insofar as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee in view of Morihara et al. and Wolf.

See reasons of record in the Office action of 3/15/00.

Conclusion

Applicant's arguments filed with respect to the pending claims have been fully considered but they are not persuasive. Applicant argues with respect to the issues of "undue breadth" and "scope of enablement" that: "The breadth of the claims is clear with respect to the disclosure." The issue in a rejection based on the *first* paragraph section 112 of 35 U.S.C. is not clarity. (Clarity is an issue with respect to the second paragraph of section 112.) In this case, the examiner has determined that the scope of the claims is such as to encompass processes that were not known at the time of the invention, but will be used in the future. This conclusion is based on Applicant's statement, made in the Remarks of 12/21/99 (page 9, lines 17-18), that the claims do encompass photolithographic processes that will be used in the future. If processes not presently known are encompassed by the claim language, then the claim language would necessarily be broader than the scope of the disclosure, because the disclosure cannot teach what is not presently known. If Applicant believes that the claim language is not intended to encompass processes not known at the time of the invention, Applicant should state this clearly on the record.

Applicant requests the "source of authority" for the examiner's conclusion that claims cannot encompass structure that cannot be produced by one of ordinary skill at the time the specification is filed. See MPEP 2164.05(a), which explains that the specification must be enabling as of the filing date. See also MPEP 2164.08, which explains that, as concerns the breadth of a claim relevant to enablement, the only relevant concern is whether the scope of enablement provided to one skilled in the art by the disclosure is commensurate with the scope of protection sought by the claims. Applicant has presented claim language that is broader in scope than the scope of enablement provided by the disclosure, and Applicant argues that this is not simply an accident of claim interpretation, but that such scope of the claim language is in fact precisely what is intended.

Applicant argues with respect to the art rejections that the prior art teachings do not discuss photolithographic processes giving rise to "the minimum photolithographic feature dimension." When a claim drawn to structure is presented using claim language that refers to a process of making, determination of patentability is not based on comparing the prior art process to the process claimed. In a patentability determination of a "product by process" claim, the question is whether the *structure produced by the claimed process* is novel and unobvious as compared to the *structure* taught in the prior art. Moreover, the burden is on the Applicant to point out specifically what *structural* differences are relied upon for patentability. See In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985), and cases cited therein. In this case, the only difference between the prior art structures, and the structures described by the claims, would (possibly) be

~~between the prior art structures, and the structures described by the claims, would (possibly) be~~ that the claimed structures are intended to be smaller than those of the prior art. As noted in the previous Office action, it would have been obvious in view of the art cited to make semiconductor structures smaller in order to fit more devices on a chip.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Crane, whose telephone number is (703) 308-4894.

The fax phone number for this Group is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 308-0956.

Sara W. Crane
Examiner
Art Unit 2811